

REMARKS

This is a full and complete response to the Final Office Action mailed May 4, 2006. In the Action, of pending claims 1-40 a variety of the claims were rejected under a variety of statutory sections, including 35 USC §101, 35 USC §102(b) and 35 USC §103(a) as detailed below. The Action contends that claims 4-10, 12, 13, and 15-17 are not entitled to the priority date of the provisional application 60/397,524. The Examiner has noted that the drawings submitted with the Amendment, filed February 27, 2007, have been accepted.

No claims have been cancelled or added. Accordingly, claims 1-40 are pending with this application. In view of the foregoing amendment and the following remarks, reconsideration of the above-captioned application is respectfully requested.

Priority

The Examiner correctly notes that Assignee inadvertently failed to petition to accept an unintentionally delayed claim for priority based on 37 CFR 1.78. A copy of such a petition is provided for the convenience of the Examiner. Therefore, the amendment to the specification regarding the claim for priority has been repeated above. It is respectfully requested that this claim for priority be entered.

Relied Upon Patent and Publication

The Action cites U.S. Patent 6,339,767 to Rivette et al. (hereinafter "Rivette"); and a publication by Coleman et al., entitled, "Aesthetics-Based Graph Layout for Human Consumption" (hereinafter "Coleman").

§101 Rejection

The Examiner has maintained his rejection under section 101 that claimed subject matter is directed to non-statutory subject matter. Specifically, the Examiner has

rejected claims 1-6, 11-13, and 17-40. This rejection by the Examiner is respectfully traversed.

The Examiner appears to reject or at least distinguish the Board of Appeals decision, Ex Parte Bilski. According to the Examiner, Bilski is “drawn to a method performed without any machine or apparatus, whereas the claimed invention is clearly disclosed as being carried out on a data processing system (see Figure 1A, *et seq.*).” See Examiner’s response, dated May 4, 2007, page 28, paragraph 46. Likewise, the Examiner disagrees with Assignee’s “technological arts” test; however, it is pointed out that Assignee applied the test from Bilski.

Regardless of whether the Examiner agrees with Bilski, a more recent case, Comiskey, has been decided by the Federal Circuit. See In re Comiskey, 499 F.3d 1365 (Fed. Cir. 2007). Comiskey appears to deal with a machine or apparatus and, therefore, addresses the Examiner’s concern regarding Bilski. Furthermore, Comiskey makes it clear that because the claimed invention is carried out “on a data processing system”, as the Examiner has conceded, the claims at issue recite statutory subject matter.

Specifically, in Comiskey, claim 17 in full is as follows (see footnote 3 of Comiskey):

A system for mandatory arbitration resolution regarding one or more unilateral documents comprising:

a registration module for enrolling a person who is executing and the one or more unilateral documents associated with the person in a mandatory arbitration

system at a time prior to or as of the time of creation of or execution of the one or more unilateral documents;

an arbitration module for incorporating arbitration language, that is specific to the enrolled person, in the in the previously enrolled unilateral document wherein the arbitration language provides that any contested issue related to the unilateral document must be presented to the mandatory arbitration system, in which the person and the one or more unilateral documents are enrolled, for binding arbitration wherein the contested issue comprises one or more of a challenge to the documents, interpretation or application of terms of the documents and execution of the documents or terms of the documents; and for providing this arbitration language to the enrolling person;

an arbitration resolution module for requiring a complainant to submit a request for arbitration resolution to the mandatory arbitration system wherein the request is directed to the contested issue related to the unilateral document containing the arbitration language; and

a means for selecting an arbitrator from an arbitrator database to conduct an arbitration resolution for the contested issue related to the unilateral document in response to the request for arbitration resolution, for providing support to the arbitrator, and where the arbitrator determines an award or a decision for the contested issue related to the unilateral document in accordance with the incorporated arbitration language, wherein the award or the decision is final and binding with respect to the complainant.

Furthermore, the Federal Circuit held that claim 17 constitutes statutory subject matter under section 101. Specifically, the court stated:

"We consider independent claims 17 and 46 separately. They recite the use of "modules," including "a registration module for enrolling" a person, "an arbitration module for incorporating arbitration language," and "an arbitration resolution module for requiring a complainant [or party] to submit a request for arbitration resolution to the mandatory arbitration system." Claim 17 also recites "a means for selecting an arbitrator from an arbitrator database." These claims, under the broadest reasonable interpretation, could require the use of a computer as part of Comiskey's arbitration system. See Alan Freedman, The Computer Glossary 268 (8th ed. 1998) (defining module as "[a] self-contained hardware or software component that interacts with a larger system); id. at 90 (defining database as "any electronically-stored collection of data")." (emphasis supplied)

Here, the Examiner has already **conceded** that "the claimed invention is clearly disclosed as being carried out on a data processing system....". Therefore, under the standards of Comiskey, it is clear that the claims in this application constitute statutory subject matter. It is, therefore, respectfully requested that the Examiner withdraw this rejection of these claims on this ground.

§102(b) Rejection

Claims 1-9, 11-16, and 18-40 were rejected under 35 USC § 102(b) as being anticipated by Rivette et al. This rejection of these claims on this ground is respectfully traversed.

As is well-known, the Manual of Patent Examining Procedure ("MPEP"), in § 2131, states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 869 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Thus, under 35 U.S.C. § 102, a claim is anticipated *only if* each and every element of the claim is found in the applied document. It is respectfully asserted that this standard has not been met in this instance.

Claim 1 currently recites:

1. A method of searching a database of data elements, the method comprising: based on a starting data element, identifying a first set of one or more data elements in the database, the data elements of the first set being referenced by the starting data element, based on the first set, identifying a second set of one or more data elements in the database, the data elements of the second set referencing one or more of the data elements of the first set, generating data based on the data elements of the first and second sets and the relationships therebetween;

the second set being identified by recursive searching, without user intervention, in which any successive search is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements.

The Examiner's position appears to be that Rivette "discloses that the desired depth of the backwards citation report desired is submitted at the same time that the starting patent is submitted. This being the case, there is no user intervention during the generation of the backwards citation report disclosed..., and so [Rivette] anticipates the claimed invention, including the newly cited limitation that the second set is identified by recursive searching without user intervention." See Examiner's Response, May 4, 2007, page 30, paragraph 47.

However, claim 1 specifically recites: "the second set being identified by recursive searching, without user intervention, in which any successive search is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements."

Thus, the language of this claim encompasses much more than the Examiner has stated and much more than is shown in Rivette. This claim encompasses an **innumerable number of recursive searches**, in which **any** successive search, in comparison with the immediately preceding search, is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated elements, **all of which occurs without any human intervention**. Therefore, it is asserted that regardless of how one chooses to read Rivette, it cannot be read to show or illustrate this feature.

It is respectfully requested that the Examiner withdraw his rejection of claim 1 under 35 U.S.C. § 102 based on Rivette. Claims 11 and 24 contain similar limitations to claim 1 and patentably distinguish on at least a similar basis. Furthermore, claims 2-9 depend from claim 1, claims 12-16 and 18-23 depend from claim 11, and claims 25-40

depend from claim 24. Assignee therefore submits that claims 2-9, 11-16, and 18-40 are therefore likewise not anticipated by Rivette. It is therefore requested that the Examiner withdraw his rejection of these claims on this basis.

§103(a) Rejection

Claims 10 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rivette in view of Coleman. This rejection of these claims is respectfully traversed.

As is well-known, the applied documents, whether considered individually or in combination, must teach or suggest all of the claim limitations of the rejected claims. However, previously, it was noted that Rivette fails to disclose or show each and every element of the rejected claims. Likewise, Coleman fails to cure the deficiency noted above with respect to Rivette. Therefore, without addressing whether or not a combination of Rivette and Coleman is proper, it is nonetheless asserted that the combination would fail to provide all of the elements of the rejected claims. Thus, the Assignee respectfully requests that the rejection of such claims be withdrawn.

Failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. It is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is not necessary to respond to every position taken by the Examiner with which Assignee does not agree in this or other correspondence. Instead, it is believed that the foregoing addresses the issues raised by the Examiner and that the present claims are in condition for allowance.

Conclusion

In view of the foregoing remarks, Assignee respectfully submits that pending claims are in condition for allowance and a notification of such allowance is respectfully requested.

If the Examiner believes that there are any remaining informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at 503.439.6500 is respectfully solicited.

Should it be determined that an additional fee is due, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account **50-3130.**

Respectfully submitted,

Dated: 11/5/07

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